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**Please find below and/or attached an Office communication concerning this application or proceeding.**

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**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Application Number: 10/797,857
Filing Date: March 10, 2004
Appellant(s): FORDHAM, MATTHEW A.

Stephen Lesavich
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 13 December 2007 appealing from the Office action mailed 16 May 2007.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**WITHDRAWN REJECTIONS**

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. Rejections of claims 1-13 and 23-27 under 35 U.S.C. 101.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

| | | |
|---|---|---|
| 6,490,575 | BERSTIS | 12-1999 |
| 6,463,430 | BRADY | 10-2002 |

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. **Claims 1, 2, 4 and 23** are rejected under 35 U.S.C. 103(a) as being unpatentable over Berstis (U.S. Patent No. 6,490,575, hereinafter referred to as BERSTIS), filed on 6 December 1999, and issued on 3 December 2002, in view of Brady et al (U.S. Patent No. 6,463,430, hereinafter referred to as BRADY), filed on 10 July 2000, and issued on 8 October 2002.

3. **As per independent claims 1 and 23**, BERSTIS, in combination with BRADY, discloses:

A method for creating a vertical search engine, comprising:

receiving a list of a plurality of keywords to be used for the vertical search engine on a network device {See BRADY, C2:L17-39, wherein this reads over "Vertical Portals"}, wherein the list of keywords includes general and specific keywords for a selected subject {See BERSTIS, C10:L49-52, wherein this reads over "lists of keywords may be periodically updated automatically"};

processing the list of plurality of keywords to create a refined list of keywords, wherein the processing includes adding, subtracting or modifying automatically the list of plurality of keywords {See BERSTIS, C10:L49-52, wherein this reads over "lists of keywords may be periodically updated automatically"};

creating a plurality of first index files associated with a plurality of first data files by checking a plurality of domain names from a plurality of domain name files associated with a domain name system for a computer network {See BERSTIS,

C8:L52-55, wherein this reads over "such resultant data includes the identity and network addresses of network sites containing one or more of the searched keywords"; and C9:L4-7, wherein this reads over "each of local sites have an associated local database which maintains a list of keywords compiled from within each site"},

wherein the plurality of first index files include a plurality of pointers to the associated data files {See BERSTIS, C9:L12-16, wherein this reads over "local indices include processing means for indexing the current keyword lists such that each of the keywords is associated with one or more of the multiple Web pages within each respective site; and C10:L43-46, wherein this reads over "such indexing entails associating each keyword with the network address of its local site or server"}, and

wherein the plurality of first data files include a plurality of entries including electronic information extracted from a plurality of web-sites associated with a plurality of active domain names from the plurality of domain name files {See BERSTIS, C10:L43-46, wherein this reads over "such indexing entails associating each keyword with the network address of its local site or server"};

creating a plurality of second index files with associated plurality of second data files by searching the plurality of first index files for keywords from the refined list of keywords {See BERSTIS, C4:L57-61, wherein this reads over "[a] global, top-level search engine maintains and periodically updates its own master index; and C10:L49-52, wherein this reads over "lists of keywords may be periodically updated automatically"},

wherein the plurality of second index files include a plurality of pointers to the associated plurality of second data files {See BERSTIS, C9:L12-16, wherein this reads over "local indices include processing means for indexing the current keyword lists such that each of the keywords is associated with one or more of the multiple Web pages within each respective site; and C10:L43-46, wherein this reads over "such indexing entails associating each keyword with the network address of its local site or server"}, and

wherein the plurality of second data files include a plurality of entries including electronic information extracted from a plurality of web-sites associated with the plurality of active domain names for keywords from the refined list of keywords {See BERSTIS, C10:L43-46, wherein this reads over "such indexing entails associating each keyword with the network address of its local site or server"};

verifying that entries in the plurality of second index files are appropriate for the selected subject;

creating a final index from the plurality of entries first index {See BERSTIS, C4:L57-59, wherein this reads over "[a] global, top-level search engine maintains and periodically updates its own master index"}, and

making a vortal accessible on another network device via the computer network for the selected subject using the final index.

It would have been obvious to one of ordinary skill in the art at the time the invention was created to verify that the entries in the second index files fall within the selected subject for the vortal. Additionally, it would have been obvious to one of ordinary skill in the art at the time the invention was

created to have the vortal available for access by another network device via a general computer network.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the inventions suggested by BERSTIS and BRADY.

One of ordinary skill in the art would have been motivated to do this modification so that in creating a vertical search engine, keywords are processed to be included in a final index such that the final index correlates to a specific subject or topic.

4. **As per dependent claim 2**, BERSTIS, in combination with BRADY, discloses:

> The method of Claim 1 further comprising a computer readable medium having stored therein instructions for causing a processor to execute the steps of the method {See BERSTIS, C11:L23-26, wherein this reads over "implementations as a computer system programmed to execute the method or methods described herein, and as a program product"}.

5. **As per dependent claim 4**, BERSTIS, in combination with BRADY, discloses:

> The method of Claim 1 wherein the plurality of entries including electronic information extracted from a plurality of web-sites associated with a plurality of active domain names from the plurality of domain name files include a title, description, a uniform resource locator, or a pre-determined amount of electronic content associated with a web-site associated with an active domain name {See BERSTIS, C4:L62-65, wherein this reads over "the global search engine would retrieve only the Internet Protocol (IP) address of the local sites associated with word-to-page links relating to the searched words"}.

6. **Claims 3, 24 and 25** are rejected under 35 U.S.C. 103(a) as being unpatentable over BERSTIS, in view of BRADY, and in further view of Admitted prior art.

BERTIS and BRADY teach the limitations of claims 1, 2, 4 and 23 for the reasons stated above.

BERTIS and BRADY differ from the claimed invention in that they fail to specifically disclose that the DNS for the Internet is included in the DNS for the network (claims 3 and 25).

BERTIS and BRADY differ from the claimed invention in that they fail to specifically disclose that the opening of a .COM, .EDU, .GOV, .MIL, .NET or .ORG top-level domain name file (claim 24).

7. **As per dependent claims 3 and 25**, it would have been obvious to one of ordinary skill in the art at the time the invention was claimed to include the Domain Names System (or "DNS") for the Internet in the DNS for the network. Because Appellant failed to provide an adequate response to

Examiner's Official Notice in the prior Office action, said failure deems the aforementioned obviousness statement to be taken as admitted prior art.

8. **As per dependent claim 24**, it would have been obvious to one of ordinary skill in the art at the time the invention was claimed to hat the name files associated with a DNS would include opening a .COM, .EDU, .GOV, .MIL, .NET or .ORG top-level domain name file associated with the DNS of the Internet. Because Appellant failed to provide an adequate response to Examiner's Official Notice in the prior Office action, said failure deems the aforementioned obviousness statement to be taken as admitted prior art.

9. **Claim 5** is rejected under 35 U.S.C. 103(a) as being unpatentable over BERSTIS, in view of BRADY, and in further view Sullivan et al (U.S. Patent No. 5,956,711, hereinafter referred to as SULLIVAN), filed on 16 January 1997, and issued on 21 September 1999.

BERTIS and BRADY teach the limitations of claims 1, 2, 4 and 23 for the reasons stated above.

BERTIS and BRADY differ from the claimed invention in that they fail to specifically disclose the method of eliminating generic keywords and adding synonyms and modified spellings of keywords to the list (claim 5).

10. **As per dependent claim 5**, BRADY, in combination with BERSTIS and SULLIVAN, discloses:

The method of Claim 1 wherein the processing step includes:

eliminating keywords that are too generic or have multiple meanings {See SULLIVAN, C4:L4-7, wherein this reads over "[a] restricted keyword list is accessed by the keyword translator which compares the user-entered input with a restricted list of acceptable keywords and acceptable synonyms"};

modifying keywords by adding alternative spellings or additional words {See SULLIVAN, C6:L1-5, wherein this reads over "even one spelling of the same word (e.g., "color" in the United States, v. "colour" in the United Kingdom)"}; and

adding automatically synonyms for keywords to the list of plurality of keywords to create the refined list of keywords {See SULLIVAN, C4:L7-10, wherein this reads over "[i]f the input is not on the list, but it is a synonym for a keyword on the list, then the keyword is substituted before storing the information"}.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the inventions suggested by BERSTIS, BRADY and SULLIVAN.

One of ordinary skill in the art would have been motivated to do this modification so that certain keywords are added or deleted according to their generic nature or similarity.

**(10) Response to Argument**

a. Rejections under 35 U.S.C. 103 – First Section

Appellant asserts the argument that the Examiner has not established a prima facie case of obviousness in violation of the holding of In re Vaeck and In re Royka. See Appeal Brief, page 34. The Examiner respectfully disagrees in that the Examiner has established a prima facie case of obviousness.

Appellant asserts the argument that BERSTIS and BRADY fail to teach or disclose "verifying that entries in the plurality of second index files are appropriate for the selected subject." See Appeal Brief, page 34. Appellant is directed to column 22, lines 17-37 of Brady et al which discloses that "[s]uch assignments can then be reviewed by a human operator for reclassification." That is, wherein the assignment involves the classification of a web page to a certain taxonomy category, the review of said assignment would appropriately read upon the recited claim limitation of verifying the appropriateness of classifying a plurality of index files for a selected subject.

Additionally, Appellant asserts the argument that the Examiner has failed in establishing a prima facie case of obviousness in that the Examiner has failed in finding prior art that satisfies the method step of "making a vortal accessible on another network device via a general computer network." See Appeal Brief, page 34. Appellant is directed to the "Background of Invention," specifically column 2, lines 17-47, of Brady et al which discloses "[t]he commercial success of vortals, such as ZDNET and eTrade." Additionally, the cited prior art further discloses the use of vortals in the Internet environment, and the World Wide Web, as well as "the increasing number of vortals and commercial enterprises on the web." See Brady et al, C2:L43-47. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the

invention was made, for said reasons above, to make a vortal acessible on another network device (i.e. another computer on the Internet or Intranet) via the computer network (i.e. the Internet). One of ordinary skill in the art would be able to clearly appreciate the prior art disclosure by Brady et al and Berstis and apply said prior art in such a manner that the method steps of the present invention are fully and completely read upon.

For purposes of clarification, the Examiner expressly disagrees with Appellant's assertion that the Examiner has simply claimed elements that were not found in the combination of references as obvious to one of ordinary skill in the art. See Appeal Brief, page 35. As cited above, the contested method steps have been fully disclosed by the prior art, and the Examiner remarks that it is the responsibility of the Appellant to review any and all cited prior art before pointing out deficiencies in a rejection and before making assertions that the Examiner has violated case law. For the reasons stated above, the rejections under 35 U.S.C. 103 are deemed clearly proper and are sustained as a prima facie case of obviousness has been established.

In response to Appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both of the inventions in the cited prior art of Brady et al and Berstis are applicable to communication networks such as the Internet and Intranet. While Appellant asserts that "[s]ince Brady requires use of a spider or crawler and Berstis in part was created to eliminate the use of a spider or crawler by requiring use of local search engines, combining Brady and Berstis makes Bertsis unsatisfactory for one of its intended purposes of eliminating use of spiders and crawlers," the Examiner disagrees. See Appeal Brief, page 39. It is noted that Brady discloses a system wherein documents are process to create a database that can be search to identify

relevant documents. Furthermore, while Brady discloses that "the term, 'network of documents,' refers to a body or collection of documents, such as the Internet, the World Wide Web, local area networks (LANs), intranets and the like." See Brady, C3:L56-59. Berstis discloses that "another object of the invention [is] to provide an improved method and system for efficiently searching a distributed, hierarchical network database, such as the World Wide Web (WWW)." See Berstis, C3:L45-48. Accordingly, it would have been obvious to one ordinary skill in the art to comprehend and recognize that the disclosed inventions do not teach away from each other but are complementary in nature by improving on search efficiency. Appellant is further advised that one of ordinary skill in the art would readily acknowledge that the terms "spider" and "crawler" are directed to automated processes which index data from a Web site or other data on a network. In fact, one of ordinary skill in the art could comprehend that search engines widely use "spidering" as a means of providing up-to-date data from the network, be it a local network or the Internet. Therefore, the Examiner notes that the cited prior art, in combination, teach and disclose the limitations of the present invention, properly rendering the claims as prima facie obvious.

Therefore, for the reasons stated above, the rejections of claims 1 and 23 are sustained under 35 U.S.C. 103(a).

As per the rejections of claims 2 and 4, the aforementioned reasons for the rejections of claims 1 and 23 under 35 U.S.C. 103(a) are incorporated herein by reference.

b. Rejections under 35 U.S.C. 103 – Second Section

Appellant asserts the argument that the Examiner's Official Notice is deficient in that the Examiner has not provided documentary evidence of proof for the Official Notice. Wherein Appellant has failed to state "why the noticed fact is not considered to be common knowledge or well-known in the art," Appellant failed to adequately traverse the Official Notice. Because Appellant has inadequately traversed the Official Notice and is therefore deficient, no document evidence shall be provided by the Examiner. Very respectfully, the Appellant should review MPEP

2144.03, which address the topic of Official Notice and clearly state the criteria for traversing an Official Notice. MPEP 2144.03, Part C states the following in part:

> To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also Chevenard, 139 F.2d at 713, 60 USPQ at 241 ("[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention."). A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice would be inadequate. (emphasis added)
>
> If applicant does not traverse the examiner's assertion of official notice or applicant's traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. (emphasis added).

Accordingly, because of Appellant's inadequate traversal, it is noted that the rejections of claims 3 and 24-25 have been modified to indicate that the limitations of the claim, which are well-known in the art, are to be taken as admitted prior art.

Additionally, while Appellant asserts that "vertical search engines could not be considered common knowledge or well-known in the art," the Examiner notes that the Official Notice rejections are directed specifically to the claimed features of a Domain Name System (or "DNS") and of having a DNS associated with a .COM, .EDU, .GOV, .MIL, .NET or .ORG top-level domain name file. Accordingly, it is noted that Appellant's arguments regarding the Official Noticed facts are misplaced as the Official Notice was not directed to the obviousness of a Vertical Search Engine but the claimed features of claims 3, 24, and 25.

c. Rejections under 35 U.S.C. 103 – Second Section

As per the rejection of claim 5, Appellant's arguments for said claim are incorporated by reference. Accordingly, the aforementioned reasons for the rejections of claims 1 and 23 under 35 U.S.C. 103(a) are incorporated herein by reference.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Paul Kim

/pk/

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